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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212445
Party	Defendant Bullsone Co., Ltd.
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Signature	/s/ Joseph J. Zito
Date	01/02/2015
Attachments	Opposition to Motion for extra time.pdf(22025 bytes) Exhibit A e-mail string.pdf(15796 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RED BULL GMBH,

Opposer,

v.

BULLSONE CO., LTD.

Applicant

Opposition No.: 91-212,445

Trademark: Bull Device with Shield

Serial No.: 79/106,767

**OPPOSITION TO
OPPOSER'S MOTION FOR SUSPENSION/EXTENSION OF TESTIMONY PERIODS**

Applicant, Bullsone, Ltd. opposes Opposer's request for an unnecessary extension of its Trial Testimony Period. On May 23, 2014, the Parties submitted an agreed Trial Schedule. [see ESTTA600124] Opposer had over six months to prepare for its Trial Testimony and apparently did not. Now, half-way through its own testimony period, without having noticed or even proposed a single date for any testimony, Opposer's counsel seeks extra time to correct its own failing.

Opposer's counsel, located in California, needs to schedule two depositions of its own employees, also located in California, prior to the 15th of January. Opposer has not stated a single reason why this cannot be accomplished. Opposer needs to propose deposition dates and send notices. Applicant's counsel has already agreed to be available on any chosen date since December 22nd. Opposer has provided no compelling reason (and in fact, no reason at all) to alter the agreed schedule to provide an additional 90 days to schedule two domestic depositions. Opposer's request to suspend/extend should be denied.

ACCURATE STATEMENT OF FACTS

This opposition proceeding has progressed with relatively few delays or interruptions. It has also progressed without Opposer producing any documentary evidence to support its opposition nor satisfy its burden as Opposer. It has progressed through the conclusion of discovery and into Opposer's Trial Testimony Period without a single document or a single answer to a single discovery request being produced by Opposer, and thus Opposer has provided no evidence to support its burden as Opposer. Opposer's Pre-Trial Statement, timely served on December 1st, is also devoid of any reference to any specific documentary evidence and it remains unclear if Opposer intends to present any documentation in support of its Opposition.

Opposer's Pre-Trial Statement also identified five potential witnesses employed by Opposer and two potential witnesses employed by Applicant. Two of Opposer's employees are located in California, the remainder of the identified witnesses are foreign.

Opposer's 30-day testimony period opened on December 17, 2014, and is scheduled to close on January 15, 2015. Opposer's counsel had a responsibility to contact its own witnesses and plan its testimony period long before December 17th. Opposer's counsel could have contacted Applicant's counsel at any time to arrange trial testimony. However, Opposer delayed contacting Applicant's counsel until the afternoon of December 19th, (Exhibit A, page 1) a Friday, two and a half days after its testimony period and begun.^{1 2} The entire e-mail exchange between counsel is attached hereto in chronological order as Exhibit A.

¹ Opposer's characterization of its two and a half day delay as "immediately" is curious.

² It should be note that although Applicant is represented by three counsel, (Mr. Stein, Ms. Benjamin and Mr. Zito), and despite the fact that all three have been cc'd on previous e-mails, Opposer's counsel contacted only Mr. Stein on Friday, December 19th and made no effort to cc: or reach out to any other co-counsel.

When Opposer's Counsel first contacted Mr. Stein, (Ex A, p.1) Opposer's counsel did not suggest or propose any dates or locations for any depositions. Opposer did not indicate how many depositions it intended to take, nor indicate if it intended to serve any written deposition questions. Despite several requests from Applicant's counsel for proposed dates, (Ex A, p.2&3) Opposer's counsel refused and continues to refuse to propose any dates for its own testimony. Opposer's counsel has not yet suggested or proposed a single date or location for a single deposition.³

Applicant's counsel Ms. Benjamin immediately replied (Ex A, p. 2) to Opposer's December 22nd e-mail that same day, Friday, December 19th,⁴ asking for proposed dates so that Applicant's counsel(s) could attend. Opposer's counsel never responded to Ms. Benjamin's December 22nd e-mail.

Applicant's co-counsel Mr. Zito responded the following day, Saturday December 20, (Ex A p.3) also asking for proposed dates and stating that he was unavailable until January 2nd. Applicant is represented by three attorneys and Opposer's counsel claims to have misunderstood the e-mail and claims to have believed that all counsel was unavailable. This alleged "misunderstanding" was cleared up the next business day, Monday December 22.

On Monday, December 22nd, the next business day after Opposer's counsel's first contact, Opposer's counsel and Mr. Zito spoke by telephone. During the telephone conference

³ It is noted that Opposer did not attach the e-mail exchange nor any exhibits in support of its motion and completely misrepresents the facts and circumstances and the actual e-mail exchange between counsel. None of Opposer's counsel's assertions are accurate.

⁴ Counsel can see no reason for the factually inaccurate statement found in Opposer's Motion: "At the end of the week, Opposer received emails from two of Applicant's counsel's "of counsel" lawyers – Ms. Amy Benjamin and Mr. Joseph Zito – . . ." As evident from the attached, there was a five hour and seven minute delay, not a "week" as intentionally misstated by Opposer's counsel.

Mr. Zito stated that Opposer was welcome to schedule depositions for any day from "Tomorrow December 23rd" through the end of the Testimony Period, January 15. In subsequent e-mail, (Ex A, p.4) Mr. Zito detailed the names of counsel who would attend on behalf of Applicant for each and every day and each and every potential location of Opposer's Trial Testimony Period. Mr. Zito also offered to extend Opposer's Trial Testimony Period for a week if Opposer's counsel so desired. Within one business day of Opposer's counsel initial contact, Applicant's counsel had agreed to be available in three different countries on each and every day of Opposer's Trial Testimony Period. It is inconceivable how Opposer's counsel can state that any Applicant's counsel presented any obstacle to Opposer's ability to conduct its Trial Testimony.

Counsel also exchanged a final set of e-mails (Ex A p. 4 - 6) on Monday December 22nd and Tuesday December 23rd. Opposer's counsel never provided a single proposed date or location, never identified which if any witness it intended to depose, never indicated if any depositions would be by written question and never responded to Mr. Zito's final e-mail of December 23rd. Opposer instead abdicated all responsibility to notice depositions and instead filed its Motion to Extend on December 23rd, without any attempt to schedule a single deposition despite Applicant's counsel being available on every single day of Opposer's Trial Testimony Period. It should be noted that Opposer's counsel did not serve any of Applicant's counsel with a copy of its Motion by e-mail or by express mail, the Motion was finally received by Applicant's counsel on Tuesday, December 30, 2014 by U.S. Mail.

The relevant portion of Mr. Zito's December 22nd e-mail, agreeing to a one week extension and agreeing that counsel for Applicant would be available at any day or time proposed by Opposer, is set forth below:

As we discussed, I am in Europe and available to attend the depositions in Austria

beginning tomorrow December 23rd and running through January 10th. After the 10th, my Associate, Ms. Sanchez, a registered EU attorney and licensed US attorney, will be available through the 15th of January.

I am available to attend in person in Southern California on January 12th and 16th- 22nd (we will agree to a one week overflow without the need to reset any other dates). We cannot agree to 30, 60 or 90 days as you have proposed. If the depositions need be set prior, Mr. Craig McLaughlin of our LA Office will attend and I will attend remotely. I am uncertain as to the availability of Ms. Benjamin, however, depending upon the dates, she will attend in person or remotely.

As for the Korean depositions, as you are aware through your direct correspondence, Mr. Kwang-chool John of the IPN Law Firm is outside counsel coordinating Bullsone's international trademark portfolio and he will be in attendance at the Korean depositions.

Given the complete and unrestricted availability of Applicant's counsel there is no basis for Opposer's request to extend.

Opposer's statement in its Brief at page 2 is knowingly incorrect:

"This meant that Red Bull's testimony period had to be limited to less than half of the 30-day testimony period in order to accommodate the schedules of Applicant's three partner-level attorneys – Michael Stein, Amy Benjamin and Joseph Zito."

Applicant placed absolutely no limitations on Opposer's testimony neither in time nor in location. In addition, Opposer does not state that it would be difficult to schedule the two California depositions (the only two live depositions) between January 2nd and January 15th. Thus there is no statement of cause or need for an extension by Opposer, even if Opposer's assertion were at all accurate.

Opposer's next statement is nonsense:

"As such, after receiving Mr. Zito's email, Opposer's counsel ceased efforts to coordinate with witnesses (particularly foreign witnesses) during the Christmas holiday week."

Opposer's counsel was only under the alleged misconception for a single day, Sunday December 21st. Thus the "during the Christmas Holiday week" makes no sense. There is no evidence that Opposer "ceased efforts" and no evidence that it ever began efforts. What is obvious is that

Opposer's counsel never made any effort whatsoever, at any time, to contact any of its witnesses to determine availability. Opposer should have already contacted its witnesses prior to December to establish availability, thus avoiding any need to try to contact them at Christmas. Opposer's counsel should have been able to propose available dates for depositions. Instead, Opposer's counsel refused to propose even a single date in response to numerous requests from Applicant's counsel. Had availability and arrangements actually been made by Opposer's counsel, these would have certainly have been shared with Applicant's counsel.

This next statement found on Page 2 of the Motion:

"After several attempts to reach Ms. Benjamin and Mr. Zito, Opposer's counsel was finally able to reach Mr. Zito yesterday."

is not correct. Opposer's counsel has offered no proof of any unsuccessful attempts to contact Applicant's counsel and Applicant's counsel is aware of none. In fact, despite the fact that Mr. Zito responded by e-mail on Saturday, Opposer's counsel did not even try to call Mr. Zito or e-mail Mr. Zito until Monday, at which time counsel spoke and Mr. Zito followed up with the above e-mail indicating full availability for the entire Testimony Period plus an additional week.

Page 3 of Opposer's Motion makes several inconsistent but telling statements, referring to (i) "European depositions on written questions" (ii) "scheduling accommodations particularly in view of the number and location of the witnesses . . ." and (iii) "an important week for Opposer to coordinate with its witnesses, particularly its European witnesses." If it was Opposer's intent to conduct the Foreign depositions (five of the seven witnesses) by written questions, as set forth in the rules, then what was the need to coordinate with opposing counsel or with the European witnesses? The European witnesses would not be answering the direct, cross, re-direct and re-cross questions until some time in March or April under the timing set forth in the rules. There

is no need to coordinate with opposing counsel and no reason for concern about the availability of opposing counsel in regard to written questions. Written questions need to be served with ten days of the start of the Testimony Period, thus they had to be served by Monday, December 29th. Opposing counsel's availability or inavailability has nothing to do with this due date.

Applicant's counsel understood, based upon Opposing counsel's implied desperate need to set up a seven witness schedule, and the need for an additional 90 days, that Opposer was asking for agreement to take Foreign depositions. Thus Applicant made counsel available in each of the foreign countries, should agreement be reached

Now it appears that the only live depositions to be scheduled are of Red Bull's own employees: *Helmut Wahl* and *Chad Peffer*, both located in Santa Monica, California. Opposer makes no assertion that it would be difficult to schedule these two depositions prior to the 15th of January. Considering the fact that Opposer's four attorney team is also located in California (four attorneys Martin R. Greenstein; Neil D. Greenstein; Angelique M. Riordan; and Leah Z. Halpert, all located in California are of record for Opposer), Applicant can perceive of no difficulty in scheduling depositions. In fact, Opposer makes no assertion that Applicant has done anything to obstruct the California depositions and made no assertions that Applicant has done anything to obstruct Opposer from preparing and serving written deposition questions.

Thus, according to Opposer's own Motion, there is no reason to grant Opposer's Motion.

LEGAL ANALYSIS

Opposer needs to establish “good cause” for the requested extension. Fed. R.Civ. P. 6(b)(1)(A) and "so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused.” *American Vitamin Products Inc. v. DowBrands Inc.*,

22 USPQ2d 1313, 1314 (TTAB 1992).

Here, as shown above, no "good cause" and in fact, no cause whatsoever has been established. Opposer's sole argument for "good cause" appears to be that Opposer cannot set up five foreign i.e. "European" depositions prior to January 15th. However, Opposer apparently had no intention of any live European depositions and intended to use written questions for these depositions, as set forth in the rules. See Opposer's assertion about "irrelevant topics such as the identity of attorneys that he planned to have attend European depositions on written questions." Since there are no European live depositions, Opposer has not alleged any cause, let alone any "good cause."

In addition, it is Opposer who has failed to be diligent, failed to propose a single deposition date and failed to draft or serve a single written deposition question. Opposer sent a generic e-mail at 2:32pm on a Friday: "I wanted to touch base with you on scheduling before I start noticing up depositions etc." and by the following Monday gave up: "We will be proceeding accordingly" and instead filed a motion for more time. This activity cannot possibly be described as "diligence."

Opposer is also "guilty of . . . bad faith." Opposer has completely misrepresented the record in an effort to claim that Applicant's counsel somehow prevented Opposer's Trial Testimony from moving forward. Misrepresentation is *per se* bad faith and is also in bad faith as it is an attempt to avoid responsibility for Opposer's own failure to properly prepare for and plan its Trial Testimony.

Applicant's counsel has agreed to complete availability as to time and location. Opposer has completely failed in its obligations by refusing to propose a single date or place. Clearly Opposer's counsel is unprepared and thus not diligent. Opposer's counsel seeks delay to

compensate for its own lack of preparation. This is not "good cause" nor diligence.

CONCLUSION

In view of the foregoing, Opposer's Motion should be denied and Opposer should complete its Testimony Period as originally scheduled. Not only has Opposer's counsel failed to be diligent and failed to set forth any good cause, Opposer's Brief is rife with inaccurate and unsubstantiated statements and accusations. A party should not be rewarded with an extension for presenting inaccurate arguments to the Board.

/s/ Joseph J. Zito
Joseph J. Zito
Michael D. Stein
Amy J. Benjamin
STEIN IP, LLC
1400 I Street, N.W., Suite 300
Washington, DC 20005

CERTIFICATE OF ELECTRONIC FILING AND SERVICE

I hereby certify that **OPPOSER'S MOTION FOR SUSPENSION/EXTENSION OF TESTIMONY PERIODS** is being filed with the TTAB electronically via ESTTA on January 2, 2015.

/s/ Joseph J. Zito
Joseph J. Zito

I certify that a true and correct copy of the foregoing **OPPOSER'S MOTION FOR SUSPENSION/EXTENSION OF TESTIMONY PERIODS** is being served on January 2, 2015, by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to counsel for Opposer and by e-mail to Counsel for Opposer:

Michael D. Stein

From: Martin R Greenstein [mailto:MRG@TechMark.com]
Sent: Friday, December 19, 2014 2:32 PM
To: Michael Stein
Subject: Red Bull GmbH v. Bullstone Co., Ltd.- Opposition No. 91-212,445 - Our Docket No. 0326.6001 - Testimony Scheduling

Hi Michael:

We are in the Opposer's testimony period now for the opposition (opened earlier this week, closes January 15, 2015) so I wanted to touch base with you on scheduling before I start noticing up depositions etc., especially given the Holiday season and travel involved.

Could you give me a call today at your convenience.

Regards,
Marty

--

Martin R. Greenstein
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No trees were killed in the sending of this message.

However, a large number of electrons were terribly inconvenienced.

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From: Amy Benjamin [mailto:amy@benjaminlawpc.com]
Sent: Friday, December 19, 2014 7:39 PM
To: Martin R Greenstein
Cc: Michael Stein; Joe Zito (external)
Subject: Red Bull v. Bullsone Opp. No. 91212445

Dear Marty:

Michael forwarded your email to me as he has left for the holiday.

Joe and I will be handling the depositions. I don't have access to Joe's schedule at the moment, so it would make more sense for you to send a proposed schedule of dates, witnesses and locations and we can go from there.

Amy

--

Amy J. Benjamin
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On 12/20/2014 1:16 PM, Joseph J. Zito wrote:

Dear Mr. Greenstein:

Further to Ms. Benjamin's e-mail below, it will not be possible to schedule any depositions prior to January 2nd, after the holiday. Because you have not provided any indication of the specific individuals, dates or locations you propose, it is not possible to comment further on availability. Please provide suggestions and we will respond regarding our availability. Please be certain to address all correspondence, pleadings, service and the like to my attention as well as that of Mr. Stein and Ms. Benjamin.

Joseph J. Zito

DNL ZITO

1250 Connecticut Avenue, NW

Suite 200

Washington, DC 20036

202 466-3500

jzito@dnlzito.com

From: Joseph J. Zito [mailto:jzito@dnlzito.com]
Sent: Monday, December 22, 2014 3:43 PM
To: Martin R Greenstein; Neil Greenstein
Cc: Amy Benjamin; Michael Stein
Subject: Re: Red Bull v. Bullsone Opp. No. 91212445

Neil:

Thanks for getting back to me today, it was good to talk to you and thank you for clarifying your intentions regarding trial testimony of Red Bull. I understand that you are out of the Country on other matters after the 12th of January and thus someone else from your office would need to cover. I presume that you will return in time for our testimony period of February 14 through March 16th. Please let us know now if there are any dates of unavailability during this period and let us know who will be covering.

It is now our understanding that you intend to take all seven depositions: two depositions in Southern California (Wahl and Peffer), three in Austria (Hellekalek, Casals and an unnamed Red Bull corporate representative) and two in South Korea (Chang-Hoon and an unnamed Bullsone corporate representative). We will need you to provide the name of the Red Bull corporate representative before the deposition. I will contact our client today and determine the name of the Bullsone representative.

You have not yet provided any dates nor times nor sequence of these depositions despite my previous request and that of Ms. Benjamin.

As we discussed, I am in Europe and available to attend the depositions in Austria beginning tomorrow December 23rd and running through January 10th. After the 10th, my Associate, Ms. Sanchez, a registered EU attorney and licensed US attorney, will be available through the 15th of January.

I am available to attend in person in Southern California on January 12th and 16th- 22nd (we will agree to a one week overflow without the need to reset any other dates). We cannot agree to 30, 60 or 90 days as you have proposed. If the depositions need be set prior, Mr. Craig McLaughlin of our LA Office will attend and I will attend remotely. I am uncertain as to the availability of Ms. Benjamin, however, depending upon the dates, she will attend in person or remotely.

As for the Korean depositions, as you are aware through your direct correspondence, Mr. Kwang-chool John of the IPN Law Firm is outside counsel coordinating Bullsone's international trademark portfolio and he will be in attendance at the Korean depositions.

We look forward to your proposed schedule and notices.

Joseph J. Zito
DNL ZITO
1250 Connecticut Avenue, NW
Suite 200
Washington, DC 20036

On 12/23/2014 1:28 AM, Neil D. Greenstein wrote:

Joe:

Thanks for your email. However, the topics and information that you attribute to me was not only NOT discussed but is incorrect. Since most of that information is not relevant to the issues at hand, there is no need to waste anyone's time for emails on those topics.

The relevant facts are:

1. You and your team are, and have been, unavailable during the first 2-1/2 weeks of Red Bull's testimony period.
2. As I mentioned to you, we can't reasonably schedule Red Bull's depositions during the time period which you have unilaterally shortened due to your team's unavailability.
3. I will be traveling outside of North America during the latter half of January returning in early February, and I am handling the depositions in this matter.
4. Since a 30-day suspension and resetting of the testimony period would conflict with my travels, I suggested a 60-day suspension/extension, but if that didn't work for you, I was perfectly willing to agree to a 90-day suspension/extension.
5. You indicated that even though the ethical and court rules, as well as typical practice and rules of cooperation and civility, don't require consultation with your client, you, as a matter of client relations wanted to speak with your client on any extension of dates.

Needless to say, your characterizations and attempt to determine who will handle depositions on behalf of my client are rejected. Moreover, your assumptions regarding the venue and form of each of the depositions is similarly rejected. Finally, your suggestion that I need to change my overseas trip without any explanation from you as to why that is necessary is rejected.

We will be proceeding accordingly.

Regards,
--Neil

Neil D. Greenstein
TechMark
Attorneys-at-Law
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Direct: (858) 779-9046
Main: (347) 514-7717, X303

Please respond to:
3525 Del Mar Heights Road, #780

On Tue, Dec 23, 2014 at 4:09 AM, Joseph J. Zito <jzito@dnlzito.com> wrote:

Neil:

0 - I fail to see how my discussion of dates, times and locations for depositions, and providing you with the names of the individuals who will be covering for Bullsone is "not relevant to the issues at hand."

1 - Your point #1 is incorrect and you are aware that it is incorrect. Perhaps you misunderstood my previous e-mail, please read my e-mail of yesterday again. We have lawyers in each of the possible deposition locations, each admitted in the local jurisdictions (including Austria, South Korea and California) standing by for the entire testimony period plus an additional week.

2 - We have shortened nothing. Mr. Martin Greenstein first contacted us regarding deposition scheduling on Friday afternoon, December 19th, four days into your testimony period. You provided no notices at that time. Ms. Benjamin responded that same evening stating she is available but did not know my schedule. I sent an e-mail the next morning, Saturday, asking for more detail and indicating that I was not able to attend until the new year. This obviously did not negate Ms. Benjamin's earlier e-mail and she and I clearly indicated that we would be sharing the responsibility for covering your testimony. Thus at least one of our team has at all times been available. You did not respond to either e-mail until Monday. I provided you with the names of the attorneys in each and every potential venue for the entire testimony period, plus a week before the close of business on Monday. We have shortened nothing and remain available for each and every day of your testimony period.

3 - You obviously knew about your own travel on other matters on the last two days of your testimony period and we cannot possibly be responsible for that.

4 - There is no need for an extension.

5 - I never stated nor indicated in any manner that it is ethical to make agreements without client consultation. We are not agreeing to any extension, as I have indicated.

6 - I have made no attempt to characterize who would handle any deposition on behalf of Red Bull and made no suggestion that you change any travel plans. You cannot reject "assumptions" as to dates and locations, only suggestions, and I made none. If my assumptions are incorrect, it is because you continue to refuse to make any suggestions or provide any notices. Please correct my erroneous assumptions by providing the scheduling information that Both Ms. Benjamin and I have requested on several occasions.

7- We remain ready and willing to attend depositions between now and January 22nd, providing you with an extra week and seeking nothing in return. Please provide notices.

8- You have yet to provide a single notice, or a single proposed date or location for a single deposition, There is simply nothing for us to be uncooperative about.

Looking forward to your notices.

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